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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,885	09/23/2003	Safaa H. Hashim	021756-060130US	2221
51206 7590 08/16/2010 TOWNSEND AND TOWNSEND AND CREW LLP/ORACLE TWO EMBARCADERO CENTER 8TH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER PORTER, RACHEL L				
ART UNIT		PAPER NUMBER		
3626				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/669,885

**Applicant(s)**

HASHIM, SAFAA H.

**Examiner**

RACHEL L. PORTER

**Art Unit**

3626

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 5/26/10.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4-6, 8-11, 14-18, 20-22, 24-27, and 30-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-6, 8-11, 14-18, 20-22, 24-27, and 30-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 May 2010 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsman's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Notice to Applicant***

1. This communication is in response to the amendment filed 5/12/09. Claims 4-6, 8-11, 14-18, 20-22, 24-27, and 30-34 are pending.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 4-6,8-11, 14-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a §101 process must (1) be tied to a particular machine or apparatus or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and should be rejected as being directed to nonstatutory subject matter.

There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent- eligible. This means the machine or transformation must

impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such a data gathering or outputting, is not sufficient to pass the test.

It is noted that claim 4 has been amended to recite "under the control of a web-based system configured with executable instructions." However, it is not clear how the phrase is intended to modify the claim language or that this phrase requires the use or involvement of a particular machine or apparatus in a meaningful way in the recited method steps.

For example, as previously explained, the claim recites "providing a web-based system for storing and organizing data related to the insurance-underwriting process...." However, the step of providing or providing access merely means making such a system available for an intended purpose that is not actively recited. It does not require the machine or system to be used.

Similarly, the additional steps of the method include configuring the system and, sharing the system, indicating that the steps are performed by the user, not the machine/apparatus itself. Thus, the current method is directed to nonstatutory subject matter.

Claims 5-6, 8-11, 14-18 contain similar deficiencies and fail to correct the deficiencies of claim 4, and are therefore also rejected.

***Claim Rejections - 35 USC § 112***

3. The rejection of claims 20-22, 24-27, 30-34 is hereby withdrawn due to the amendment filed on 5/26/10.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4-6, 8-11, 14-18, 20-22, 24-27, and 30-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Surbey et al (US 2004/0186750A1) in view of Moore et al (US 2003/0195776A1 )

[claim 4] Surbey et al discloses a method for facilitating communication among participants in an insurance underwriting process, comprising:

under the control of a web-based system configured with executable instructions, (Figure 2; pars. 81-83)

- providing access to a web-based system, wherein the web-based system comprising is implemented using a multi-level modular architecture ( par. 40-43), comprising a web-based portal, the web-based portal providing access to a plurality of web- based applications, each web-based application employing a desktop visual metaphor and providing access, via said desktop visual metaphor,

to a plurality of business modules, each business module providing access to a plurality of business logic tools, each business logic tool providing access to a plurality of views for displaying data, the plurality of views including a summary view, a list view, and a details view; (Figure 2; par. 45-48; 50, 105, 110)

- configuring the web-based system such that each business module of each web-based application provides access to a common set of generic business logic tools;. (par. 48, 121-123)
- configuring the web-based system such that each business logic tool of each business module provides access to a common set of generic views; (par. 38,42, 48, Figures 2,9 collaboration engine)
- sharing, via the web-based system, the data among the participants; (par. 46-48)
- wherein the participants comprise at least one user, and the web-based system is adapted to restrict data accessible to the at least one user based on a plurality of attributes of the at least one user. (Figures 2, 9—user authentication; 137-141)

Claim 4 has been amended to recite the details of the plurality of views. In particular, claim 4 has been amended to recite: “the plurality of views including a summary view providing an agent information summarizing cases the agent is handling, a list view providing the agent a list of cases the agent is handling, and a details view providing the agent case-specific information for cases the agent is handling...”

Surbey discloses a method of providing access to a web-based system as explained above, and provides summary views and lists, (par. 46—e.g. searchable directory; par. 50—*audit trail/ software that systematically keeps track of every collaboration, document, message, and/or interaction, thereby providing a complete and reliable "memory".*) However, Surbey does not expressly disclose a summary view providing an agent information summarizing cases the agent is handling, a list view providing the agent a list of cases the agent is handling, and a details view providing the agent case-specific information for cases the agent is handling.

Moore discloses a summary view/ list providing an agent information summarizing cases the agent is handling, a list view providing the agent a list of cases the agent is handling, and a details view providing the agent case-specific information for cases the agent is handling. (Figures 22a—query sort request screen; Figures 22B-22D; par. 86-88) At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Surbey with the teaching of Moore to provide views detailing specific information to a user (e.g. agent). As suggested by Moore, one would have been motivated to include this feature to provide faster review, and greater convenience for underwriters when a case must be reviewed. (par. 15-16)

[claims 5-6] Surbey et al discloses the method of claim 4 wherein said participants are selected from a group consisting of insurance agents and insurance agencies. (Figure 2; par. 38,42—users include various insurance brokers and insurance companies) and

wherein the at least one user is selected from a group consisting of agents and case managers. (par. 38,42; Figure 2)

[claims 8-10] Surbey discloses the method of claim 4, wherein the plurality of modules are adapted to allow the plurality of web-based applications to be scalable(par. 78, 81-82, 134—load balancer) ; wherein the plurality of business modules are purchased incrementally(par. 130); wherein the plurality of modules comprises : a user profile module; a general administration module; and a business module. (par. 141-143 Figure 9 )

[claims 11] Surbey discloses the method of claim 4, wherein the business logic tools plurality of tools comprises at least one generic tool and at least one entity-specific tool, said at least one entity-specific tool being accessible by a subset of the participants to whom said at least one generic tool is accessible. (par. 45-47 and 89- *software that allows a user to initiate collaboration with any number of other users both within their own organization or externally.; access rules for virtual community determined by user*)

[claim 14] Surbey discloses the method of claim 4, wherein the multi-layer, modular architecture is adapted to allow development of new web-based applications, modules, business logic tools, or views. (par. 36, 41-43)

[claim 15] Surbey discloses the method of claim 4, wherein the plurality of attributes of the at least one user comprises: the at least one user's role in the insurance



underwriting process; the at least one user's identity; and a context in which the at least one user seeks access to the data. (Figure 9, par. 41-43)

[claim 16] Surbey discloses the method of claim 4, wherein sharing the data further comprises encrypting the data using a secure encryption technology. (Figure 9, par. 144)

[claim 17] Surbey discloses The method of claim 4, wherein the web-based portal is hosted by a third party. (par. 54)

[claim 18] Surbey discloses the method of claim 4, wherein the web-based system is deployed on a framework for the plurality of web-based applications (Figures 8-9; par. 46 and 89).

[claims 20-22,24-27,30-34] The limitations of claims 20-22,24-27,30-34 are addressed by the rejections of claims 4-6, 8-11, 14-18.

System claims 20-22,24-27,30-34 repeat the subject matter of claims 4-6, 8-11, and 14-18 as a set of elements rather than a series of steps. As the underlying process has been shown to be fully disclosed by the teachings of Surbey in the above rejection of claims 4-6, 8-11, 14-18, it is readily apparent that the Surbey reference includes a system to perform the recited functions. As such, these limitations are rejected for the same reasons provided in the rejection of claim 4-6, 8-11, 14-18, and incorporated herein.

Claim 20 has been further amended to recite: "a web-based system comprising a data store in communication with at least one processor." Surbey discloses a web-

based system comprising a data store in communication with at least one processor  
(Figure 2; par. 81-83)

### ***Response to Arguments***

6. Applicant's arguments filed 5/26/10 have been fully considered but they are not persuasive.

Applicant argues newly added limitations. In response, the Examiner has provided additional citations from the reference to address the new limitations.

(A) Applicant argues that Surbey fails to disclose the type of interface employed by various service layers, or the particular manner in which each service layer provides access to their included layer.

In response, the Examiner respectfully disagrees with the applicant's interpretation of Surbey. Like applicant's invention, Surbey provides a web-based system with allows participants/users to communicate through the use of collaborative tools and applications. (Figures 2 and 9; par. 39, 46). Surbey also discloses access rights (i.e. the particular manner in which service layer provides access to their included modules).

As further explained in the rejections under 35 USC 101, the current claim language fails to actively define or describe particular steps performed in the current method claims which distinguish over the prior art. In particular, the current wording of exemplary method claim 4 consists primarily of making the system available (i.e.

providing)), rather than defining steps actively performed (using a particular machine or apparatus) during the inventive method.

(B) Applicant argues that Surbey fails to disclose "business logic tools."

In response, the Examiner understands this to be a non-technical, general and non-specific term. The applicant's own specification fails to provide a definition for the term. The Surbey reference discloses several "functionalities" which serve as "business logic tools." (see par. 40-43; 44-48).

(C) Applicant argues that claim 4 has been amended to overcome the rejection under 35 USC 101.

In response the rejection has been maintained and additional reasons have been provided in the 101 rejection of the current Office Action. It is noted that the claim has been amended to recite "under the control of a web-based system configured with executable instructions." However, it is not clear how this phrase is intended to modify the claim language or that this phrase requires the use or involvement of a particular machine or apparatus in a meaningful way in the recited method steps.

For example, the claim recites "providing a web-based system for storing and organizing data related to the insurance-underwriting process...." However, the step of providing or providing access merely means making such a system available for an intended purpose that is not actively recited. It does not require the machine or system to be used.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Grover et al (US 2002/0188484A1).
8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **RACHEL L. PORTER** whose telephone number is (571)272-6775. The examiner can normally be reached on M-F, 10-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. L. P./  
Examiner, Art Unit 3626

/Robert Morgan/  
Supervisory Patent Examiner, Art Unit 3626